

The Examiner contends that inventions II and I are related as a product and process of use. The Examiner finds that the inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP §806.05(h)). The Examiner contends that in the instant case the aqueous solution as claimed can be used in a materially different method such as a cleaning method.

Because these inventions are allegedly distinct for the reasons given above and have acquired a supposed separate status in the art as shown by their different classification and recognized divergent subject matter, the restriction for examination purposes as indicated is contended by the Examiner to be proper.

The Applicants' attorney does not recall a telephone call from the Examiner on August 25, 2003, but it is certainly possible that the call may have been missed somehow.

The Applicants would respectfully elect with traverse to prosecute the claims of the alleged independent and distinct **Group I invention, claims 1-10**.

Applicants respectfully traverse the restriction requirement as not complying with the statutory law in this area. Specifically, the Examiner has made no showing that the two sets of claims are "independent *and* distinct." The law states, in 37 CFR §1.142, that:

"(a) If two or more *independent and* distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction ..."
(Emphasis added.)

While there is some difference in the way this statute is interpreted in the MPEP, it should be noted that:

"The MPEP ... is entitled to notice so far as it is an official interpretation of the statutes or regulations with which it is not in conflict." See *Litton Systems, Inc. v. Whirlpool Corp.*, 221 U.S.P.Q. 97, 107 (Fed. Cir. 1984).

As the MPEP is in *direct* conflict with the law on this point, it is not entitled to any weight on the matter. It is respectfully noted that the Examiner only argues distinctness in the rejection.

The alleged distinct inventions herein have not been shown to be independent as required by 37 CFR §1.142. In fact, an aqueous solution such as that recited in independent claim 11 would naturally result from the method of claim 1. The Examiner is respectfully invited to compare these two claims. Furthermore, it would be difficult, if not impossible, to know how a composition such as that recited in dependent claim 12 could result without practicing a method such as that recited in claim 1. Again, the Examiner is respectfully invited to compare these two claims. The aqueous solutions of claims 11-19 cannot be made without the methods of the claims of Group I, and the methods of claims 1-10 would make the solutions of the claims of Group II, and for these reasons are therefore not independent each from the other.

Further, the Examiner's argument that the products of Group II can be used in a materially different method such as a cleaning method is respectfully traversed. It is respectfully submitted that the Examiner has provided no support in the record for this proposition. The Applicants respectfully submit that it is additionally difficult to see how the compositions of dependent claim 12 that requires a non-aqueous phase could be used in a cleaning method as supposed by the Examiner.

Finally, the fact that the claims of groups I and II may fall into different search categories is irrelevant when considering the requirement of restriction. As the Commissioner may from time to time reorganize the Art Groups, restrictions based upon this type of reasoning would allow the Commissioner to arbitrarily decide what is and is not subject to restriction. In other words, the division of art groups does not necessarily have anything to do with divisions of technology or inventions. When a particular art group gets to be too large, a logical area to divide the group is determined. This division does not necessarily define separate inventive areas, but is arbitrary. Using the Examiner's reasoning and the example above, a restriction could be required on one day because of the separation of art groups that could not have been requested the day before. The passage of time and the arbitrary division of art groups should not enter into the restriction

requirement. This is not the intent or the proper application of the restriction requirement. Reconsideration is respectfully requested.

It is respectfully submitted that the arguments presented above overcome the instant restriction requirement. Reconsideration of the requirement and allowance of the claims are respectfully requested. The Examiner is respectfully reminded of his duty to indicate allowable subject matter. The Examiner is invited to call the Applicant's attorney at the number below for any reason, especially any reason that may help advance the prosecution.

Respectfully submitted,
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